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Subsection (b) of 35 U.S.C. § 132,
effective May 29, 2000, provides for
continued examination of a utility or plant
application filed on or after June 8, 1995



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. P4628-D1-1-C1-1
(SLDZ200121-3-1-3(I))

IN RE APPLICATION OF: Sullivan et al.

Prior application No.: 09/840,475

Filing Date: April 23, 2001

Examiner: Buttner

Art Unit: 1712

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified pending prior application.

For: GOLF BALL WITH DUAL CORE AND POLYURETHANE COVER

1. **Submission required under 37 C.F.R. § 1.114**

- ☒ Previously submitted
- ☒ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on July 17, 2003 (copy enclosed)
- ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
- ☐ Other
- ☒ Enclosed
- ☒ Amendment/Reply
- ☐ Affidavit(s)/Declaration(s)
- ☐ Information Disclosure Statement (IDS)
- ☐ Other
- 10/17/2003 RCE/DAF1 00000100 09040475
- | | |
|------------|-----------|
| 01 FC:1001 | 770.00 02 |
| 02 FC:1202 | 90.00 02 |
| 03 FC:1253 | 350.00 02 |

2. **Miscellaneous**

- ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months.
- ☐ Other

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner For Patents, Box 1450, Alexandria, VA 22313-1450, on October 10, 2003.

Mary Ann Temesvari
Mary Ann Temesvari

3. x The filing fee is calculated below.

CLAIMS AS FILED IN THE PRIOR APPLICATION LESS ANY CLAIMS CANCELED BY PRELIMINARY AMENDMENT			
Basic Filing Fee (Large Entity)			\$ 770.00
		No. of Extra Claims Present	Additional Rate
Total Claims	25	5	\$ 90.00
Indep. Claims	3	0	\$ 0.00

Total fee \$ 860.00

4. **Fees**

X The Director is hereby authorized to charge any fee deficiencies or credit any overpayments, to Deposit Account No. 06-0308.

X Check in the amount of \$ 860.00 is enclosed.

 Applicants are entitled to small entity status.

5. XX Applicants petition for a three (3) month extension of time under 37 C.F.R. § 1.136 extending the period for reply to at least October 17, 2003 to file this RCE. A check in the amount of \$950.00 is enclosed. Applicants request and authorize any additional extensions which may be required to be charged to Deposit Account No. 06-0308.

6. xxx Please address all future communications to

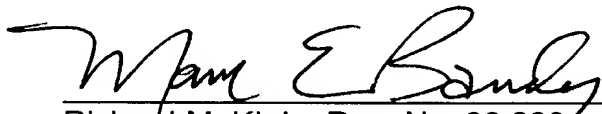
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Oct 10, 2003

Date

24492

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE APPLICATION OF : Sullivan et al.
FOR : **GOLF BALL WITH DUAL CORE AND
POLYURETHANE COVER**
SERIAL NO. : 09/840,475
FILED : April 23, 2001
ART UNIT : 1712
EXAMINER : D. Buttner
LAST OFFICE ACTION : April 17, 2003
CONFIRMATION NO. : 5756
CUSTOMER NO. : 24492
ATTORNEY DOCKET NO. : P-4628-D1-1-C1-1
SLDZ200121-3-1-3(I)

Cleveland, Ohio 44114-2579
October 10, 2003

**Request for Continued Examination (RCE)
and Response to Advisory Action**

Mail Stop
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants herein present a request for continued examination (RCE)
of the above-captioned application.

CERTIFICATE OF MAILING

I hereby certify that this correspondence and related papers are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 10/10, 2003.

By: Mary Ann Temesvari
Mary Ann Temesvari

This RCE is presented so that a previously submitted Response, filed on July 17, 2003, and amendments therein, will be considered by the Examiner.

Applicants also herein address an Advisory Action in this application mailed August 4, 2003. In that Advisory Action, the Examiner refused to enter amendments that were previously presented in the above-noted July 17 Response. Specifically, after stating that the proposed amendments would not be entered, the Examiner asserted:

[R]equiring center to be powdered metal or alloy is new issue. Excluding metal or alloy from core layer (ii) is broader than previous claims which excluded all density adjusting fillers. New rejections may be necessitated. No previous claim required hard inner cover, soft plastic urethane outer cover and metal in center.

Argument that Moriyama, Hayashi and Herbert are not combinable is not relevant to the applied rejection. The rejection uses the three in the alternative when combined with Rajagopalan or Sullivan. In other words, the rejection is premised on substituting Moriyama's fillers with the fillers named by Rajagopalan and Sullivan (eg W,Ti). Similarly, it is obvious to substitute Hayashi's fillers with the fillers of Rajagopalan and Sullivan (eg W,Ti). The equivalent rationale is used for substituting for Herbert's fillers.

Even if proposed amdt. was entered, Melvin would still meet many of the claims. Melvin's core has metal (tungsten) in the center and no metal in the outer core (see example 1).

Applicant has not pointed out clear basis in spec for requiring filler (esp metal) in the center and excluding filler (esp metal) from outer core.

Applicants hereby submit their previously presented Response of July 17, 2003, and request that this Response and accompanying amendments be considered.

Furthermore, concerning the Examiner's assertions in the Advisory Action (set forth above), Applicant responds as follows.

As to the Examiner's dismissal of Applicants' concern that the patents to Moriyama, Hayashi, and Herbert are not properly combinable, it is respectfully submitted that such concern is directly relevant to the rejections. The previously filed Response explained why such a collection of patents was not supportable. See pages 13-16 of that Response. The Examiner's reliance upon such an assortment of patents is a prime example of hindsight reconstruction. Specifically, the Examiner's conclusion of obviousness was not reached in accordance with the standard of analysis pronounced by the Court of Appeals for the Federal Circuit. Even if the collection of patents are selectively combined in the manner that the Examiner

attempts, the resulting combination still fails to render any of the claims obvious. Furthermore, attempting to make the combination ignores specific teachings in the very patents themselves that expressly prohibit such combination. Each of the cited patents teach away from the attempted combination and also from the subject matter of the claims.

Next, the Examiner contended (in the Advisory Action) that the patent to Melvin "would still meet many of the claims." No. As explained on page 18 of the July 17, 2003 Response, the '562 patent to Melvin et al. entirely fails to disclose or teach the features recited in independent claims 1, 19, and 26. Furthermore, Melvin also fails to disclose or teach the combination of multiple features called out in the dependent claims.

Finally, the Examiner contended that Applicants have not pointed out "clear basis in spec for requiring filler (esp metal) in the center and excluding filler (esp metal) from outer core." Applicants submit the following. The specification provides ample support for a feature of filler material (especially metal) in the center. For example, the specification notes:

The center core component has at least one density adjusting filler material dispersed throughout a polymeric material.

Page 5, lines 24-26.

The specification continues and notes:

[A] center core component which includes...at least one density increasing filler material that has a specific gravity in the range of from 1 to 20.

Page 6, lines 4-6.

Additionally, the specification describes:

[T]he core center component comprises one or more density-increasing materials...

Page 8, lines 23-24.

The specification continues and describes:

[T]he core center component comprises one or more density-increasing filler materials...Examples of preferred density-increasing materials are included herein.

Page 46, lines 19-25.

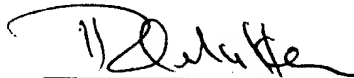
Numerous density-increasing filler materials are noted on pages 54-57, including metals, powdered metals, and various metal alloys.

The Examiner also questioned whether support exists for "excluding filler (esp metal) from outer core." The specification provides abundant support for this feature. Specifically, it is repeatedly noted throughout the application that the core layer is "formed from a thermoset material, a thermoplastic material, or combinations thereof." See p. 8, lines 15-16. See also p. 47, lines 17-20. Several preferred golf ball embodiments in which the core layer is formed from a thermoset material are shown in figs. 4 and 6. Fig. 5 illustrates an embodiment in which a core layer is formed from a thermoplastic material. These are examples of specific disclosures in which the core layer does not contain any density adjusting filler.

In view of the foregoing, and the previously submitted Response (enclosed herewith), it is urged that all pending claims are in condition for allowance.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP



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